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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/586,881 | 06/05/2000 | Mordhay Barkan | | 8240 |

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EXAMINER

DASS, HARISH T

ART UNIT PAPER NUMBER

3628

DATE MAILED: 01/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 09/586,881 | Applicant(s) BARKAN, MORDHAY | |
| | Examiner Harish T. Dass | Art Unit 3628 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 35-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 35-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-14 and 15-34 are canceled.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 41-45 are rejected under 35 U.S.C. 102(e) as being anticipated by Hill (US 6,236,981).

Re. Claim 41, Hill discloses the user sends to the second party a report including information relating to the digital token used and canceled by the user while using the service for which a payment by digital tokens was required [figure C3 L13-L28; C4 L28-L33; C5 L12-L15; C6 L3-L60],

the second party maintains a database of previous reports relating to digital tokens used in the past, and the report received in step (a) is added to the database [C57-L76];

the second party compares the information received in step (a) with previous reports for the same user (verify) [C6 L33-L50], and if the comparison detects a violation of the rules for the use of digital tokens [C6 L48 to C7 L23], then the second party

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performs one or more of: stores that information, displays a violation report, reports that to the digital tokens issuer, sends a note to the user of such digital token [C11 L5061; C12 L15-L45].

Re. Claim 42, Hill discloses wherein in step (b) the second party maintains a database of previous reports relating to digital tokens used in the past by the user [C14 L40-L48].

Re. Claim 43, Hill discloses wherein in step (b) the second party maintains a database of previous reports relating to digital tokens used in the past by a plurality of other users [C14 L40-L48; C9 L9-L67].

Re. Claim 44, Hill discloses wherein in step (b) the database of previous reports is being updated to include the latest reports, and the oldest reports are deleted there from [C12 L34-L45; C10 L64 to C11 L7].

Re. Claim 45, Hill disclose wherein in step (d) one of the rules for use of digital tokens is that no digital token is allowed to be used twice (prevent double spending) [C12 L8-L27].

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 35-37 and 46-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hill (US 6,236,981) in view of Walker et al (hereinafter Walker - US 5,949,875).

Re. Claim 35, Hill discloses acquiring by a user of digital tokens from the digital tokens issuer and storing the digital tokens [C2 L2 to C4 L44; C5 L15-24, C5 L31-41; C8 L1-L17], and

canceling the used digital tokens (cleared tokens), that are being used by the user according to computerized predefined criteria [Figure 10; C8 L18-31; C9 L6-L8, C9 L44-L67; C12-L8-L48; C13 L3-L6].

Hill does not explicitly disclose user's tokens database and the user uses the service provided by the third party.

However, Walker discloses user's tokens database [C1 L53-L56; C7 L15-L18; C6 L18-20] and the user uses the service provided by the third party [C3 L23-L40] to allow user of short-term or single usage to use the service and make a secure payment using digital tokens and the system to keep track of the digital tokens used. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Hill and include user's tokens database and the user uses the service provided by the third party as disclosed by Walker, to allow users to purchase digital tokens and pay for the on-line service provided to him/her by the provider in secure way.

Re. Claim 36, Hill discloses wherein the digital tokens can be in different predefined values [C5 L31-L41; C12 L48-L67].

Re. Claim 37, Hill discloses wherein the digital tokens are cryptography protected from fraud [C2 L33-L35, C2 L52-L63].

Re. Claims 46-47, neither Hill nor Walker explicitly discloses wherein in step (d) one of the rules for use of digital tokens is that the serial number of successive digital tokens should be in ascending order, and wherein in step (d) one of the rules for use of digital tokens is that the serial number of issued digital tokens should correspond to a digital document or digital permit issued by third party. However these are business choice and an easy way to administer the used, stolen, lost and damaged digital tokens. For example, American Express issues traveler checks in different denomination values and serial numbers in ascending orders, which are assigned to customer. When customer uses a check and gives it to vendor he/she logs the check number serially in log sheet or in case a check is lost by customer or vendor, it can be reported to American Express by user ID and traveler check serial number which makes it easier for user/vendor as well as American Express to update their list. It would have been obvious to one of ordinary skill in the art at the time the Applicant's invention was made to modify disclosures Hill and Walker and include serial number of successive tokens should be in ascending order to provide better accounting and management.

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Claims 38-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hill in view of Walker, as applies to claim 41 above, and further in view of Business wire "Subscriber Computing Inc. Installs Real-Time Information System Suite For Douglas Telecommunications Inc.", Nov. 19, 1997 (hereinafter Subscriber).

Re. Claims 38-40, neither Hill nor Walker explicitly discloses wherein the digital tokens can be generated by the user himself according to special and secure digital permit from the digital tokens issuer and according to predefined criteria in different predefined values, wherein the service can be the usage of predefined software package that is in the user's possession, and wherein the service can be the usage of wireless resources or any other digital communication means to another user, while the collecting payment party is not involved in the communication. However, Subscriber discloses these steps [see entire document 3 pages; (licensees) (cellular solution) (software-based prepaid metered billing solution)] to provide license to users (carriers) for using Prepay service. Further software licensing is known, for example, Informix database is licensed to large companies, where they (companies) incorporate Informix database to their product and sell it to others. It would have been obvious to one of ordinary skill in the art at the time the Applicant's invention was made to combine disclosures Hill and Walker, and Subscriber to allow user (carriers) to provide prepaid digital token service in response to competitive issues.

Response to Arguments

3. Applicant's arguments, filed on Sept. 02, 2005, with respect to amended claims have been considered but are moot in view of the new ground(s) of rejection.

In response to applicant's argument, the recitation, "Claims 38-40 and 46 were rejected ..."

a. Typo error by applicant. The title of the rejection reads "Claims 38-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hill as applies to claim 41 above, in view of Business wire "Subscriber Computing Inc. Installs Real-Time Information System Suite For Douglas Telecommunications Inc.", Nov. 19, 1997 (hereinafter Subscriber)". On claims 38-40 were rejected.

b. Applicant argues that "the propriety of Subscriber as a prior art document is respectfully challenged ..." Applicant's argument is not persuasive because the second of Subscriber (page 2 which has a 18 printed at lower right corner) discloses that this software was installed on August 22 "The installation went off without a hitch, and we were live on August 22, as planned." Which means a side from the staff of Subscriber Computing Inc., people at Douglas Telecommunications Inc. were aware of the product and that makes it public regardless of when the Business wire reported it.

Conclusion

3. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harish T. Dass whose telephone number is 571-272-6793. The examiner can normally be reached on 8:00 AM to 4:50 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough can be reached on 571-272-6799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Harish T Dass
Examiner
Art Unit 3628

01/03/2006


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